

APPLICANT(S): Rosenberg, et al.  
SERIAL NO.: 09/557,262  
FILED: April 24, 2000  
Page 6

### **REMARKS**

Claims 61-91 are pending in the application. Claims 61-80, 82-88, 90 and 91 have been rejected. Claims 62, 63, 65, 68, 71, 72, 77, 79, 81, 84, 85, 88 and 89 have been cancelled. Claims 61, 64, 66-67, 69-70, 73, 74-76, 78, 80, 82-83, 86-87, 90 and 91 have been amended. The amendments to the claims are editorial in nature and contain no new matter. Therefore, Applicants respectfully request entry of the Amendment.

### **CLAIM REJECTIONS - 35 U.S.C. § 112 FIRST PARAGRAPH**

In the Office Action, the Examiner rejected claims 61-80, 82-88, 90 and 91 under 35 U.S.C. § 112, first paragraph as allegedly failing to convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Examiner admitted, however, that the specification is enabling for: 1) an isolated nucleic acid that encodes a human or mouse 3-OST-1 protein, wherein said isolated nucleic acid comprises the nucleotide sequence of SEQ ID NO 1 or SEQ ID NO 3, and wherein said isolated nucleic acid encodes the protein disclosed in SEQ ID NO 2 and SEQ ID NO 4; 2) an isolated nucleic acid that encodes a 3-O-sulfotransferase domain of the human or mouse 3-OST-1 protein wherein the domain consists of residue 53-311 or 21-307 of SEQ ID NO 2, or residue 49-307 or 21-303 of SEQ ID NO 4, and wherein the human or mouse 3-OST-1 protein has sequence specific HS-binding activity; and 3) an isolated host cell selected from the group consisting of bacterial, yeast, insect and mammalian cells, wherein the mammalian cells are selected from the group consisting of COS-7 cells, HCO, murine primary cardiac microvasculature endothelial cells, murine mast cell line C57.1, human primary endothelial cells or umbilical vein, F9 embryonal carcinoma cells, rat fat pad endothelial cells and L cells, wherein the host cell comprises the nucleic acid.

APPLICANT(S): Rosenberg, et al.  
SERIAL NO.: 09/557,262  
FILED: April 24, 2000  
Page 7

Applicants have herein amended claims 66 and 86 to recite an isolated nucleic acid comprising a nucleic acid sequence with at least 90 % nucleotide sequence identity with nucleotide coordinates 323-1255, or 119-1039 of SEQ ID NO: 1, or 3, respectively. Support for such a claim may be found on Page 18, lines 31-32 of the Specification. Further, on Page 13 of the Specification, at lines 9-11, the fact that the murine and human sequences share 85 % nucleotide sequence identity, and encode polypeptides that share 93 % amino acid sequence identity is described. The specification therefore describes sequences that despite having a difference of 15 % in nucleotide sequence, the encoded proteins nonetheless exhibit 3-OST-1 activity, teaching one skilled in the art a nucleic acid sequence with at least 90 % identity, yet encoding for such activity.

Applicants submit that the amended claims are therefore enabled. Applicants are pursuing the subject matter of the cancelled claims in a subsequent application. Accordingly, Applicants respectfully request withdrawal of the rejection, and allowance of the amended claims.

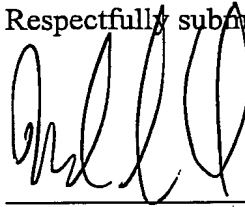
Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this paper to deposit account No. 05-0649.

APPLICANT(S): Rosenberg, et al.  
SERIAL NO.: 09/557,262  
FILED: April 24, 2000  
Page 8

Please charge any fees associated with this paper to deposit account No. 05-0649.

Respectfully submitted,



---

Mark S. Cohen  
Attorney for Applicant(s)  
Registration No. 42,425

Dated: February 11, 2004

**Eitan, Pearl, Latzer & Cohen Zedek, LLP.**  
10 Rockefeller Plaza, Suite 1001  
New York, New York 10020  
Tel: (212) 632-3480  
Fax: (212) 632-3489